

REMARKS

Claims 1-12 are pending in the application. Claims 1 and 4 have been amended above. As to the amendment, see, e.g., Applicant's specification at page 6, lines 10-11. Claim 12 previously was presented as Claim 1.

Claims 1-11 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (U.S. Patent 6,798,767) in view of Eastep (U.S. Patent 6,731,625).

Applicants traverse the obviousness rejections as follows. Three separate and independent grounds are set forth.

(1)

Applicant's claim 1 as amended is further distinguished over Alexander. As recited in Applicant's claim 1, "a telephone comprising said telephone controller can be connected by a user having no knowledge of IP and LAN". A telephone comprising Alexander's telephone controller requires a knowledgeable user to make the connection. This distinction between Applicant's claim 1 and Alexander is substantial and patentably significant.

Moreover, Eastep fails to this additional feature missing from Alexander. Eastep relates to the integration of the Internet with telephony systems. Eastep does not suggest motivation for making a telephone with Alexander's controller connectible by a LAN/IP unsophisticated user. For instance, Eastep teaches that to adopt MCI's "ISDN, an end user or company must upgrade to ISDN terminal equipment, central office hardware, and central office software." The upgrade that Eastep requires clearly requires someone sophisticated, not unsophisticated, to connect telephones. Even with Alexander and Eastep, a person of ordinary skill in the art would not be motivated to invent a telephone controller that makes a telephone connectable by a user unsophisticated in LAN/IP. Thus, claims 1 and 4, and the claims depending thereon, are non-obvious over Alexander and Eastep.

There are additional, separate reasons for non-obviousness. Namely, Applicant rebuts several of the Examiner's assumptions set forth in the office action.

(2)

For example, Alexander only deals with users' IP addresses (see, e.g., Fig. 4B) but fails to teach ID comprising a domain name. The Examiner admits that Alexander fails to expressly disclose that the ID comprises a domain name but

incorrectly trivializes this recitation and, to allegedly supply this deficiency in Alexander, the Examiner resorts to Eastep and proposes to modify one of the extensions assigned by Alexander to be an email address. The Examiner's position (page 4) is that at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Alexander to assign an extension which is an email address; the Examiner states that the motivation would have been to allow the use of a familiar identifier to uniquely identify the user.

Applicant respectfully rebuts the Examiner's assumption regarding how a person of ordinary skill in the art allegedly would be motivated to modify Alexander based on Eastep. A person of ordinary skill in the art reading Eastep and Alexander would not take away from Eastep that he should try to modify Alexander to use an email address in assigning an extension. The Examiner is only able to make that email address-related proposal because the Examiner has the benefit of Applicant's present claims and specification. The person of ordinary skill in the art, unschooled by Applicant's claims or specification, would not see that in Eastep and Alexander.

Rather, the person of ordinary skill in the art would see that Alexander provides a system for generating line appearances at one or more alternate telephony devices with a target telephony device in response to a call made to the target telephony device. (Col. 1, lines 40-45.) In Alexander, the user may associate one or more alternate devices with a target telephony device such that the alternate devices are rung when a call is placed to the target telephony device. (Col. 2, lines 12-15.) It would not make sense to try to introduce email addresses into Alexander—that does not readily fit into Alexander and would only be a complicating factor. The Examiner's theory that using email addresses would somehow improve Alexander because supposedly that would permit unique identification of the user is not technically valid, because Alexander is already accomplishing what he needs to do using unique identifying alternate numbers and IP addresses (Figs. 3, 4B). Rather, if a person of ordinary skill in the art were given Alexander and Eastep and asked for his thoughts, on the points for which the Examiner has tried to combine them, the references would seem separate to him. Objectively speaking, Eastep would not cause him to focus on use of IP addresses in Alexander.

For the above-stated reasons, the assumption that Eastep allegedly provides motivation to modify Alexander to change an extension to an email address has been

rebutted. This assumption having been rebutted, the obviousness rejection should be withdrawn.

(3)

Another reason for non-obviousness is as follows.

Applicants' claim 1 recites a table that stores an ID comprising a domain name. Alexander is lacking Applicant's inventive table because Alexander's table is missing the ID. Although the Examiner admits (page 3) that Alexander fails to disclose that the ID, extension and the IP address are all stored in a single table, the Examiner gives insufficient weight to the differences between Alexander and Applicant's claimed invention. The Examiner's assumption (page 3) is that at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Alexander to combine tables 4A and 4B. The Examiner alleges cost reduction as motivation.

Applicant rebuts the Examiner's cost-reduction assumption as follows. Alexander is able to accomplish his objective of getting alternate telephony devices to ring by using his table (Fig. 4B) which includes IP address but without including something further such as ID comprising a domain name. Because Alexander can accomplish what he wants to do with his "simple" table (Fig. 4B), adding anything to Alexander's table would only be an unnecessary complicating factor and therefore cannot reasonably be characterized as cost-reducing as the Examiner proposes. Therefore, the assumption that Alexander's simple table would be modified has been rebutted. This assumption underlying the obviousness rejection having been rebutted, the obviousness rejection should be withdrawn.

Thus, for any one of the multiple reasons set forth above, Applicant's claims 1 and 4 are clearly non-obvious over Alexander and Eastep, and the obviousness rejection should be withdrawn.

With regard to independent claim 12, which previously was presented as claim 1, Applicant traverses the obviousness rejection based on Alexander combined with Eastep. The primary reference, Alexander, is missing many recitations of Applicant's independent claim 1. While the Examiner admits the deficiencies in Alexander, the Examiner declines to recognize that Applicant's invention recited in claim 1 is substantially and patentably different from Alexander.

Applicants' inventive telephone controller as recited in claim 12 provides a

property not possessed by Alexander. Namely, a telephone comprising the telephone controller of Applicants' claim 1 is connectible by a user who has no knowledge of IP and LAN. See Applicant's specification at page 6, lines 10-11, which is evidence under oath and should be considered as if stated in a Declaration Under 37 C.F.R.

132. By contrast, a telephone comprising Alexander's controller would be unconnectible by the same unsophisticated user. This point was raised by Applicant previously, and the Examiner has not disagreed. "Presence of a property (connectability by a user unsophisticated with IP/LAN) not possessed by the prior art is evidence of nonobviousness." MPEP 716.02(a) *citing In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963).

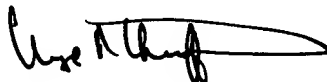
Also, for the reasons set forth in sections (2) and (3) above, Applicant's Claim 12 is not obvious over Alexander combined with Eastep.

Reconsideration and withdrawal of the obviousness rejections are respectfully requested. It is respectfully requested that the application be reconsidered, that claims 1-12 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephone or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis Christofferson & Cook).

Respectfully submitted,



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